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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,195	12/05/2000	Hitoshi Ishikawa	Q62115	6703

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01/07/2003

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EXAMINER

YAMNITZKY, MARIE ROSE

ART UNIT

PAPER NUMBER

1774

16

DATE MAILED: 01/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/729,195

Applicant(s)

ISHIKAWA ET AL.

Examiner

Marie R. Yamnitzky

Art Unit

1774

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 December 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 23 December 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☒ they raise the issue of new matter (see Note below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
- MEY  
01/04/03  
5. ☒ The a) ☒ <sup>declaration</sup> affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 1-25.

Claim(s) withdrawn from consideration: None.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 12.
10. ☐ Other: \_\_\_\_\_

Continuation of 2. NOTE: Proposed new claims 26-29 require further consideration at least under 35 U.S.C. 112, 1st par. (support for "hydrocarbon based substituent"?), 35 U.S.C. 112, 2nd par. (scope of "hydrocarbon based substituent"?), and 35 U.S.C. 103(a).

Continuation of 5. does NOT place the application in condition for allowance because:

Neither of the two "distinct features" argued by applicants are required by finally rejected claim 1, and various of the other finally rejected claims do not require at least one of the two argued "distinct features". For example, finally rejected claim 2 requires a substituent at the R6 position (the argued first distinct feature) but does not require the substituent at the ortho position (the argued second distinct feature). Prior art compounds of formulae (48)-(52) as shown in JP 9-268284 have a substituent at the R6 position and meet all the other limitations of the compound as required by finally rejected claim 2.

The examiner has considered the data set forth in the unexecuted Rule 132 Declaration filed 12/23/02 and does not find the data to be persuasive as to the patentability of the finally rejected claims. With respect to the rejections under 35 U.S.C. 102(b), see *In re Malagari*, 499 F.2d 1289, 182 USPQ 549, 553 (CCPA 1974) wherein the court stated that anticipation "cannot be overcome by evidence of unexpected results or teachings away in the art" citing *In re Wiggins*, 488 F.2d 538, 179 USPQ 421 (CCPA 1973). Also note that the device made with Compound 1, referred to in the declaration as a comparative example, meets the limitations of at least rejected claim 1. With respect to the rejection under 35 U.S.C. 103(a), the data presented in the Rule 132 Declaration are not commensurate in scope with the finally rejected claims. Compound 2, referred to in the declaration as an inventive example, does not meet the limitations of the compound required by finally rejected claim 17. Compound 2 is also more restrictive than the compound required by any of the finally rejected claims; none of the finally rejected claims require three butoxy groups at ortho- and para-positions. For example, claim 5 only requires one substituent at an ortho-position; the substituent at the second ortho-position and the substituent at the para-position of compound 2 as set forth in the declaration are not required by claim 5. It cannot be determined from the data set forth in the declaration that the presence of one substituent at an ortho position is solely responsible for the improvements resulting from the use of compound 2.



MARIE YAMNITZKY  
PRIMARY EXAMINER

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